

Appl. No. 10/802,268
Reply to Office Action of April 13, 2006

Attorney Docket No. 2003-0710 / 24061.121
Customer No. 42717

REMARKS

Claims 1-20 are present in the application. In view of the remarks that follow, Applicants respectfully request reconsideration.

Independent Claim 9

Independent Claim 9 stands rejected under 35 U.S.C. §102 as anticipated by Wang U.S. Patent No. 6,789,031. This ground of rejection is respectfully traversed, for the following reasons. The PTO specifies in MPEP §2131 that, in order for a reference to anticipate a claim under §102, the reference must disclose each and every element recited in the claim. Claim 9 expressly recites:

... a process parameter for manufacturing a semiconductor product ..., and ... using the calculated process parameter in a manufacturing process to fabricate the semiconductor product ...

The Office Action asserts on page 9 that:

Both the Applicant and Wang are using information gathered from a part being manufactured in order to establish the process parameter within a semiconductor (i.e. IC) fabrication process.

However, this assertion is simply not a true statement. More specifically, The Office Action points out references in Wang to a "parameter". But contrary to the assertions in the Office Action, Wang does not use his parameter in the specific manner that is expressly recited in Applicants' Claim 9. In particular, Wang does not disclose use of his parameter "for manufacturing a semiconductor product", nor does Wang disclose use of his parameter "in a manufacturing process to fabricate the semiconductor product". Consequently, Wang does not disclose each and every element that is recited in Applicants' Claim 9, and Wang thus does not satisfy the PTO requirement that is mentioned above and that is set forth in MPEP §2131.

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Accordingly, since the PTO requirement for anticipation is clearly not met, Claim 9 is not anticipated under §102 by Wang. Claim 9 is thus believed to be allowable, and notice to that effect is respectfully requested.

Independent Claim 1

Independent Claim 1 stands rejected under 35 U.S.C. §102 as anticipated by Wang. This ground of rejection is respectfully traversed, for the following reasons. The PTO specifies in MPEP §2131 that, in order for a reference to anticipate a claim under §102, the reference must disclose each and every element recited in the claim. Claim 1 expressly recites:

... a process parameter for manufacturing a semiconductor
product

The Office Action points out references in Wang to a "parameter". However, and contrary to the assertions in the Office Action, Wang does not use his parameter in the specific manner that is expressly recited in Applicants' Claim 1. In particular, Wang does not disclose use of his parameter "for manufacturing a semiconductor product". Consequently, Wang does not disclose each and every element that is recited in Applicants' Claim 1, and Wang thus does not satisfy the PTO requirement that is mentioned above and that is set forth in MPEP §2131. Accordingly, since the PTO requirement for anticipation is clearly not met, Claim 1 is not anticipated under §102 by Wang. Claim 1 is thus believed to be allowable, and notice to that effect is respectfully requested.

Independent Claim 16

Independent Claim 16 stands rejected under 35 USC §103 as obvious in view of a proposed combination of teachings from Wang and from Skidmore U.S. Patent No. 6,622,102. This ground of rejection is respectfully traversed. the PTO recognizes in MPEP §2142 that:

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The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

Applicants respectfully submit that Wang and Skidmore fail to establish a *prima facie* case of obviousness under §103 with respect to Claim 16, for mutually exclusive reasons that are discussed below.

THE PROPOSED COMBINATION DOESN'T TEACH THE CLAIMED SUBJECT MATTER

The provisions of MPEP §2142 specify with respect to §103 that:

To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations. (Emphasis added).

The PTO considers this requirement to be important, as evidenced by the fact that this exact language appears not only in MPEP §2142, but also in other sections of the MPEP, including MPEP §706.02(j) and MPEP §2143. Applicants' Claim 16 recites a system that includes:

. . . a process parameter value to be used in manufacturing a semiconductor product . . . , . . . the system including: a semiconductor fabrication tool configured to execute a fabrication process using the process parameter value

The Office Action asserts that these limitations from Claim 16 are met by the Wang patent. However, as discussed above in association with Claim 9, Wang does not teach or suggest subject matter comparable to these limitations from Claim 16. In particular, the Office Action points out references in Wang to a "parameter". But Wang never uses his parameter in the

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specific manner that is expressly recited in Applicants' Claim 16. In particular, and contrary to the assertions in the Office Action, Wang does not disclose use of his parameter "in manufacturing a semiconductor product", nor does Wang disclose use of his parameter in "a semiconductor fabrication tool configured to execute a fabrication process using the process parameter value". As to Skidmore, the Office Action does not rely on Skidmore for teachings that would meet these quoted limitations from Applicants' Claim 16. Instead, the Office Action relies on Skidmore for different teachings, relating to the selection of one or more part identifiers.

Consequently, the proposed combination of teachings set forth in the Office Action does not include anything comparable to the limitations from Claim 16 that have been quoted above. In other words, even when the indicated teachings from Wang and Skidmore are combined, they fail to satisfy the requirement of MPEP §2142 that the combined teachings must collectively "teach or suggest all the claim limitations" (emphasis added). Therefore, for this independent reason alone, it is respectfully submitted that Claim 16 is not obvious under §103 in view of Wang and Skidmore, and notice to that effect is respectfully requested.

THE COMBINATION OF REFERENCES IS IMPROPER

There is yet another reason why Wang and Skidmore cannot be combined in the proposed manner to reject Claim 16 under §103. In this regard, MPEP §2142 specifies that:

To establish a *prima facie* case of obviousness, . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. . . . The teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art, and not based on applicant's disclosure.

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As discussed above, neither Wang nor Skidmore teaches a parameter comparable to the parameter recited in Applicants' Claim 16, including use of such a parameter "in manufacturing a semiconductor product", or use of such a parameter in "a semiconductor fabrication tool configured to execute a fabrication process using the process parameter value". Consequently, even assuming that a person skilled in the art might possibly consider combining Wang and Skidmore, there is nothing in the prior art that would motivate such a person to add to this combination a new element that is not disclosed in either Wang or Skidmore. The §103 rejection of Claim 16 is therefore not complete, because it fails to demonstrate suitable motivation as required by the MPEP. In effect, the §103 rejection is based on hindsight of Applicants' disclosure, rather than on motivation properly derived from what was known prior to the present invention. But as discussed above, this approach is expressly prohibited by MPEP §2142, which states that motivation "must . . . be found in the prior art, and not based on applicant's disclosure". Accordingly, for this independent reason alone, it is respectfully submitted that the Office Action fails to properly establish motivation, and therefore fails to properly establish a *prima facie* case of obviousness under §103. Claim 16 is thus not obvious in view of Wang and Skidmore, and notice to that effect is respectfully requested.

In view of the various different reasons discussed above, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness in the manner required by the MPEP, and that Claim 16 is therefore not obvious in view of Wang and Skidmore. Claim 16 is therefore believed to be allowable, and notice to that effect is respectfully requested.

Independent Claim 10

Independent Claim 10 stands rejected under 35 USC §103 as obvious in view of a proposed combination of teachings from Wang and Skidmore. This ground of rejection is respectfully traversed. As discussed above, the PTO recognizes in MPEP §2142 that:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not

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produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

Applicants respectfully submit that Wang and Skidmore fail to establish a *prima facie* case of obviousness under §103 with respect to Claim 10. More specifically, Claim 10 expressly recites:

... a process parameter value to be used in manufacturing a semiconductor product

For reasons similar to those discussed above in association with Claim 16, it is respectfully submitted that the Examiner has failed to properly establish a *prima facie* case of obviousness in the manner required by the MPEP, and that Claim 10 is therefore not obvious in view of Wang and Skidmore. Claim 10 is therefore believed to be allowable, and notice to that effect is respectfully requested.

Dependent Claims

Claims 2-8, Claims 11-15, and Claims 17-20 respectively depend from Claim 1, Claim 10 and Claim 16, and are also believed to be distinct from the art of record, for example for the same reasons discussed above with respect to Claims 1, 10 and 16, respectively.

Conclusion

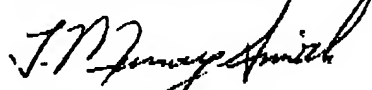
Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

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Although Applicants believe that no fee is due in association with the filing of this paper, the Commissioner is hereby authorized to charge any fee required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone LLP.

Respectfully submitted,



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Date: May 25, 2006

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Enclosures: None

R-135769.1